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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/077,606 07/30/98 JIANG

P 040388/0113

EXAMINER

HM12/0430

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TING, M

ART UNIT

PAPER NUMBER

1644

DATE MAILED:

04/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Advisory Action

Application No.
09/077,606

Applicant(s)
Jiang, et al.

Examiner
Mary B. Tung

Art Unit
1644



– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

THE REPLY FILED Apr 16, 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on Feb 28, 2001. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☐ they raise the issue of new matter. (See NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

4. ☒ Applicant's reply has overcome the following rejection(s):
See attached
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
Claim(s) allowed: 43, 44, 46, 51-59, 61, 62, 64, 69, 72-75, 78, 79, 84, and 85
Claim(s) objected to: 76, 77, 82, 83, and 86-89
Claim(s) rejected: 45, 48-50, 63, and 65-67
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
11. ☐ Other: _____

SUPPLEMENT TO ADVISORY ACTION

Claims 1-41 were originally presented.

Claims 39-41 were cancelled in the paper filed June 2 1998, Paper No. 5.

Claims 12-22 and 25-32 were cancelled in the paper filed 4/27/00, Paper No. 15.

Claims 42-89 were added in Paper No. 15.

Claims 42, 47, 60, 68, 70, 71, 80 and 81 were cancelled in the amendment filed 2/28/2001, Paper No. 18.

Claims 1-11, 23, 24 and 33-38 stand directed to a non-elected invention.

In light of the Request for Reconsideration, filed 4/16/2001, Paper No. 20, Paper No. 18, filed under 37 C.F.R. §1.116 has been entered.

Claim Rejections - 35 U.S.C. § 102

1. The rejection of claims 43-46, 48-53, 61-67, 72, 74, 76, 82, 84, 86 and 88 under 35 U.S.C. 102(b) as being anticipated by Zeng, et al. (*Biol. Chem. Hoppe-Seyler*, 375:393-399) is hereby withdrawn in light of the evidence provided by Applicants that the Zheng, et al. sequence comprises a peptide sequence not comprised by the Applicants' sequence (see page 6, paragraph of Paper No. 18).
2. Claims 45, 48-50, 63 and 65-67 are rejected under 35 U.S.C. 102(b) as being anticipated by Glass and Fuchs (*J. Cell Biol.* 101:2366-2373, 1985).
3. Glass and Fuchs teach a 469 amino acid polypeptide encoded by SEQ ID NO: 1, with 98.5% identity over its entire length with SEQ ID NO: 3 of the instant application, 97.0% identity with residues no. 2-135 of SEQ ID NO: 4 of the instant application, and 100% identity with SEQ ID NO: 5 of the instant application (see Figure 6, GenBank Accession No. P08729 and B24177). Therefore, the reference teaching anticipates the claimed invention.
4. The Applicant's argue that keratins have properties totally different from the properties of sarcolectins. Additionally, the claimed antibodies would bind to the recited sequences, as discussed in Paper No. 16. Although the Examiner agrees that sarcolectin is not the same as a keratin, the keratins have the recited properties, as discussed in Paper No. 16, and thus the limitations of the claims are met.

5. Claims 45, 48-50, 63 and 65-67 are rejected under 35 U.S.C. 102(b) as being anticipated by Glass and Fuchs (*J. Cell Biol.* 107:1337-1350, 1988).
6. Glass and Fuchs teach a 469 amino acid polypeptide encoded by SEQ ID NO: 1, with 97.6% identity over its entire length with SEQ ID NO: 3 of the instant application, 94.0% identity with residues no. 2-135 of SEQ ID NO: 4 of the instant application, and 100 % identity with SEQ ID NO: 5 of the instant application (see Figure 6, GenBank Accession No. B24177). Therefore, the reference teaching anticipates the claimed invention.
7. The Applicant's arguments, and Examiner's response were discussed, *supra*.

Allowable Subject Matter

8. Claims 76, 77, 82, 83, 86-89 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
9. Claims 43, 44, 46, 51, 52-59, 61, 62, 64, 69, 72-75, 78, 79, 84 and 85 are allowed.

Conclusion

10. Papers related to this application may be submitted to Group 1640 by facsimile transmission. Papers should be faxed to Group 1640 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). THE CM1 FAX CENTER TELEPHONE NUMBER IS (703) 305-3014 or (703) 308-4242.
11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Mary Tung whose telephone number is (703)308-9344. The Examiner can normally be reached Tuesday through Friday from 8:30 am to 6:00 pm, and on alternating Mondays. A message may be left on the Examiner's voice mail service. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1640 receptionist whose telephone number is (703) 308-0196.

Mary B. Tung
August 25, 2000
Mary B. Tung, Ph.D.
Patent Examiner
Group 1640

David A. Saunders
DAVID SAUNDERS
PRIMARY EXAMINER
ART UNIT 1644